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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/275,722	03/24/1999	DAVID A. LEE	113622	1130

31817 7590 12/26/2007  
SCHWABE, WILLIAMSON & WYATT, P.C.  
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1211 S.W. FIFTH AVE.  
PORTLAND, OR 97204

EXAMINER
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GYORFI, THOMAS A

ART UNIT	PAPER NUMBER
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2135

MAIL DATE	DELIVERY MODE
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12/26/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

09/275,722

Applicant(s)

LEE, DAVID A.

Examiner

Tom Gyorfi

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. Claims 1-10 remain for examination. The correspondence filed 5/9/07 amended claims 1, 3-6, 9, and 10.

### ***Response to Arguments***

2. Applicant's arguments, see pages 4-6 of the amendment filed 5/9/07, with respect to the rejections under 35 USC 103 have been fully considered and are persuasive. The rejections under 35 USC 103 of claims 1-10 have been withdrawn.
3. Examiner contacted Applicant's representative Robert Peck on 12/19/07 in order to propose an Examiner's Amendment to remedy the outstanding 35 USC 101 rejection and place the instant application in condition for allowance. Applicant's representative informed Examiner that Applicant's representative would not be able to obtain the Applicant's authorization for an Examiner's Amendment within the time allotted to the Examiner for response to this Office Action, thus necessitating this Office Action.

### ***Claim Rejections - 35 USC § 101***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
5. Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. It is observed that Applicant amended the claims to recite wherein the computing device performs the various limitations of the claimed method to produce, and store in memory, a shared secret key; however, even

after rectifying the previously noted issue of a tangible embodiment [or lack thereof], it is still observed that the claimed methods are directed toward producing a shared secret [cryptographic] key, without a corresponding recited practical application for said key. As a result, the claims preempt every substantial practical application for a shared secret key [e.g. one could use the key to encrypt data on one's own computing device], even though the sole purpose for said key as disclosed in the specification is to provide for a secure communication channel between a first digital platform and a second digital platform (specification, page 15, lines 9 and 21-23). One may not patent every "substantial practical application" of an idea, law of nature, or natural phenomena because such a patent would "in practical effect be a patent on the [idea, law of nature, or natural phenomena] itself." *Gottschalk v. Benson*, 409 U.S. 63, 71-72, 175 USPQ 673, 676 (1972). See also *In re Schrader*, 22 F.3d at 293-94, 30 USPQ2d at 1458-59 and *In re Warmerdam*, 33 F.3d at 1360, 31 USPQ2d at 1759; and also MPEP 2106 and 2106.02. Once again, Examiner respectfully suggests that the rejection could be overcome by amending claim 1 to explicitly recite wherein the shared secret key is used to provide a secure communication channel between a first digital platform and a second digital platform, thus reciting a practical application for the claimed method(s).

***Allowable Subject Matter***

6. Claims 1-10 are allowable, pending resolution of the 101 rejections above.

***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tom Gyorfi whose telephone number is (571) 272-3849. The examiner can normally be reached on 8:30am - 5:00pm Monday - Friday.

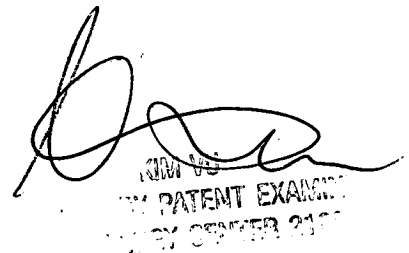
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TAG  
12/19/07



Handwritten signature and official stamp. The stamp includes the text: "PATENT EXAMINER", "EBC", and "2135".